

REMARKS

This Response is in reply to the Office Action mailed May 11, 2005. Claims 1-25 remain in the case. Claims 26-28 are added. Reconsideration based on the above amendments and the remarks below is kindly requested.

Formal Rejections

Claims 4 and 21 are rejected under 35 U.S.C. §112, second paragraph. The Examiner alleges that the term "substantially bottomless" in claim 1 is contradicted by a limitation in claim 4 that the base member is "provided at a base region ... and fixedly secured to at least one of said shell or lining."

Applicant respectfully traverses this rejection. It is clear from Fig. 2 and others that the ceramic shell may be configured to define a large or pass-through bottom opening and hence be "substantially bottomless," yet still possess a base region at the base of the shell to which the base member may be fixedly secured.

In addition, claim 4 has been amended to recite that the "ceramic shell includes a *shell wall*" and that the base member is "fixedly secured to at least one of *said shell wall or metallic lining*." Claim 21, dependent from claim 4, has been amended for consistency. Applicant respectfully submits that as amended claims 4 and 21 particularly point out and distinctly claim the subject matter of the invention. Applicant also brings new independent claim 26 to the attention of the Examiner. This claim recites: "a ceramic shell having a shell wall provided substantially about said metallic lining, said ceramic shell being configured to define a bottom opening." Dependent claim 27 includes limitations similar to claim 4.

Claim 15 and its dependents (16-20) are rejected under 35 U.S.C. §112, 2nd paragraph, for use of the term "said ceramic lining." Applicant has amended this typographical error in claim 15, and thanks the Examiner for pointing it out.

Substantive Rejections

Claims 1-25 are rejected under 35 U.S.C. §103 as being unpatentable over Todd and Tung, in view of Hawn, Payson and Mitrovich.

Applicant respectfully traverses this rejection. Todd and Tung each teach a double walled vessel having a plastic shell and a metal liner. Plastic, however, is quite different than ceramic.

Plastic has well known elastomeric properties and as a result, metal may be crimped or compressed onto plastic in a manner that forms a secure bond, yet does not break the plastic. Due to the respective properties of metal and plastic, they are commonly used together. Consider, for example, portable electronic devices, appliances, automobile interiors, entertainment devices, domestic articles, etc. These items and many others combine plastic and metal.

Ceramic, in contrast, is rigid and more fragile. Forming metal to ceramic may break it, or a good seal between components may be hard or expensive to achieve. For that reason, it is far rarer to find items that combine ceramic and metal (and normally when these two materials are combined it is because of their electrical or thermal properties, e.g., insulated electrical conductors or capacitors, etc.).

Referring specifically to the Tung and Todd references, these references do not allude or suggest the use of other materials, and particularly not fragile, rigid materials such as ceramic. Tung uses a *compressive insertion* of annular projection 61 into annular groove 72 to join materials. Todd uses a *compressive insertion* of the container flange 24 past threads 32 into annular cap member 27 (Fig. 2) and a *compressive insertion* of bead 38 into annular groove 37 (Fig. 3).

Both references rely on the elastic properties of plastic to function and do not suggest use of a rigid, non-flexible material such as ceramic. *Due to the physical difference between plastic and ceramic, fabrication techniques for plastic do not necessarily suggest fabrication techniques for ceramic or inclusion of ceramic in a double walled drinking vessel.*

The Hawn reference teaches decorative packaging made of ceramic. The ceramic substrate or housing of Hawn may be painted or have a decal applied to it. Applicant respectfully submits that the mere

presence of an article (i.e., a decorative housing) does not suggest its combination with metal in a double walled vessel.

Furthermore, the technical question of how to overcome the lack of elasticity or compressive fit afforded by the plastic devices of Tung and Todd is not addressed by Hawn.

The Payson and Mitrovich references both teach a double walled vessel in which the inner wall and the outer wall are made of glass. While glass and ceramic have some similar properties, the fabrication of two walls of the same material does not necessarily suggest the formation and joining of two walls of different materials. Firstly, walls formed of the same material will have the same coefficient of expansion and hence will expand and contract at the same rate. This fosters formation of a high integrity, leak-proof seal between the walls, among other benefits. Secondly, if the two walls are made of the same material, then the walls may be formed and/or joined in the same processing steps, rendering fabrication more efficient and joint formation potentially more secure. *Formation of walls of the same material does not suggest fabrication of walls of different material, particularly as diverse as metal and ceramic.*

Accordingly, Applicant respectfully submits that the combination of Todd, Tung, Hawn, Payson and Mitrovich do not disclose or suggest the present invention.

Prior Art Teaches Away from Invention

Applicant respectfully submits that the cited references teach that metal should be combined with plastic and that glass or ceramic should stand alone (i.e., not be combined with another material). These teachings teach away from the present invention.

Improper Use of Applicant's Disclosure

"Decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden *ex post* analysis." *In Re Mahurkar Patent Litigation*, 831 F.2d Supp. 1354, 28 USPQ2d 1801, *aff'd* 71 F.3d 1573, 37 USPQ2d 1138 (1995). It is impermissible to use the inventors' disclosure as a "road map" for

selecting and combining prior art disclosures. ATD Corp. v. Lydall, Inc., 159 F.3d 534, 48 USPQ2d 1321 (Fed. Cir. 1998).

Applicant respectfully suggests that the Examiner is using Applicant's disclosure as a way of finding "suggestion" between the cited references when no suggestion in fact exists.

Commercial Significance - Secondary Consideration

Commercial significance has long been an indicator of nonobviousness. Enclosed herewith is a declaration of Matthew J. Fildes, Product Development Director for Pacific Cornetta, Inc. (PCI), the assignee of the present invention. Mr. Fildes' declaration indicates that several mug manufacturers have introduced a mug product that falls within the scope of the pending claims. The companies are listed by name and address in the declaration.

Applicant respectfully submits that the strong commercial interest of PCI competitors in producing a mug that falls within the scope of the pending claims is an indication of the commercial significance of the present invention and hence its nonobviousness.

New Claims

New claims 26-27 are discussed above under the heading "Formal Rejections." New claim 28 is dependent from claim 23 and recites a peripherally disposed recess provided in the shell that is utilized in mounting a metallic member.

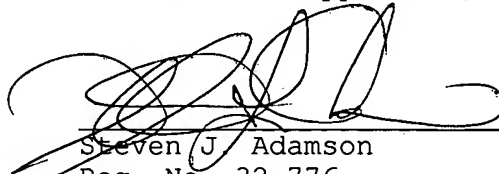
In view of the foregoing Amendments and these Remarks, Applicant respectfully submits that Claims 1-28 are now in condition for allowance and early notification of same is respectfully requested. Should the Examiner believe that a telephone conference would help further the prosecution of this case, the Examiner is requested to contact the undersigned at the listed telephone number.

The Assistant Commissioner is hereby authorized to charge underpayment of any fees (including any filing fees under 37 C.F.R. \$1.16 for additional claims and any patent application processing fees under 37 C.F.R. \$1.17 including any fee for extension of time)

associated with this communication or credit any overpayment to Deposit Account No. 01-0272. A duplicate copy of this authorization is enclosed.

Respectfully Submitted
on behalf of Applicant,

Date: 7-29-05


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